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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,127	08/21/2003	Krystof C. Zmudzinski	884.930US1	7122
21186	7590	06/14/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.			WORJLOH, JALATEE	
P.O. BOX 2938				
MINNEAPOLIS, MN 55402			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,127

Applicant(s)

ZMUDZINSKI ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 13-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-12) in the reply filed on May 8, 2006 is acknowledged.

2. Claims 13-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on May 8, 2006.

3. Claims 1-12 have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Publication No. 2005/0102240 to Misra et al.

Referring to claim 8, Misra et al. disclose enabling execution of an application (i.e. resource) on a master device (i.e. license server) by allocating master license (i.e. license pack) and at least one sharable license (i.e. individual software license) to the master device and

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enabling execution of the application (i.e. resource) on a sharable device for a selected time period by allocating the sharable license to the sharable device (i.e. client) (see paragraphs [0014], [0015] & [0052] and claim 5 of Misra et al. – the license generator at the clearinghouse creates a license pack containing a set of one or more individual software license, the license pack is transmitted to a license server, which in turns distributes individual licenses to clients. The client then uses the license to gain access to the resources provided.).

Referring to claim 9, Misra et al. disclose storing a master license code (i.e. license pack ID) associated with the master license in the master device (see paragraph [0063]) and storing a sharable license code (i.e. unique license ID) associated with the license in the shareable device (see paragraph [0066]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2005/0102240 to Misra et al. in view of US Publication No. 2002/0138441 to Lopatic.

Referring to claim 1, Misra et al. disclose enabling execution of a first application (i.e. resource) on a master device (i.e. license server) by allocating master license (i.e. license pack) and at least one sharable license (i.e. individual software license) to the master device and

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enabling execution of a second application (i.e. resource) on a sharable device by executing the first application on the master device and by allocating the sharable license to the sharable device (i.e. client) (see paragraphs [0014], [0015] & [0052] – the license generator at the clearinghouse creates a license pack containing a set of one or more individual software license, the license pack is transmitted to a license server, which in turns distributes individual licenses to clients. The client then uses the license to gain access to the resources provided.). Misra et al. do not expressly disclose two different applications (i.e. first application and second application). Lopatic discloses a first application (master copy of the software) and a second application (modified copy of the software) (see paragraph [0032]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra et al. to include a first application and a second application. One of ordinary skill in the art would have been motivated to do this because it provides individualized copies of the software product while monitoring the execution of each software product in agreement with the individual license terms (see Lopatic paragraph [0017]).

Referring to claim 2, Misra et al. disclose allocating a plurality of shareable licensees including the shareable license to the master device (see paragraph [0014] –the license generator sends the license pack, which contains a set of one or more individual software license, to the license server).

Referring to claim 3, Misra et al. disclose allocating the plurality of shareable licenses to a corresponding plurality of shareable device (see paragraph [0015] – the license server distributes the software licenses contained in the license pack to individual clients).

Referring to claim 4, Misra et al. disclose monitoring software licenses that have been granted to clients (see paragraph [0035]) and querying licenses (see paragraph [0068]). Misra et al. do not expressly disclose receiving a query at the master device to determine current execution of the first application. Lopatic discloses receiving a query at the master device to determine current execution of the first application (see paragraph [0018] – the execution of each individualized software product is monitored and paragraph [0167] – the license server receives a request including identification information to run the software product and searches for a license matching the identification information). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra et al. to include the step of receiving a query at the master device to determine current execution of the first application. One of ordinary skill in the art would have been motivated to do this because it controls the transfer of licenses (see Lopatic paragraph [0018]).

Referring to claim 5, Misra et al. discloses receiving a response (i.e. the challenge) at the sharable device to verify the current execution of the first application (see paragraph [0108] –the client requests a license; in response, the license server initiates a client challenge to determine who the client is).

Referring to claim 6, Misra et al. disclose execution of an application (i.e. resource) on the shareable device. Misra et al. do not expressly disclose terminating the execution of the second application on the shareable device after failing to receive a response verifying current execution of the first application on the master device. Lopatic discloses terminating the execution of the second application on the shareable device after failing to receive a response verifying current execution of the first application on the master device (see paragraph [0032] –

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Lopatic teaches continuing an execution of the individual download copy if a permission to run is obtained and aborting the execution otherwise). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra et al. to include the step of terminating the execution of the second application on the shareable device after failing to receive a response verifying current execution of the first application on the master device. One of ordinary skill in the art would have been motivated to do this because it protects the rights of the software supplier and control the transfer of licenses (see paragraphs [0017] & [0018] of Lopatic).

Referring to claim 7, Misra et al. discovering the existence of the master device and the first application by the shareable device and receiving the second application by the sharable device (see claim 1 above – the client request a license to access the resource; once granted the license he can use the resource). Misra et al. do not expressly disclose two different applications (i.e. first application and second application). Lopatic discloses a first application (master copy of the software) and a second application (modified copy of the software) (see paragraph [0032]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Misra et al. to include a first application and a second application. One of ordinary skill in the art would have been motivated to do this because it provides individualized copies of the software product while monitoring the execution of each software product in agreement with the individual license terms (see Lopatic paragraph [0017]).

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8. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. as applied to claim 8 above, and further in view of Lopatic.

Referring to claim 10, Misra et al. disclose license pack ID (see claim 8 above). Misra et al. do not expressly disclose augmenting the application to include an application code to check against a master license code stored in the master device. Lopatic discloses augmenting the application to include an application code to check against a master license code stored in the master device (see paragraph [0030]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Misra et al. reference to include an application code to check against a master license code stored in the master device. One of ordinary skill in the art would have been motivated to do this because it protects the rights of the software supplier and control the transfer of licenses (see paragraphs [0017] & [0018] of Lopatic).

Referring to claim 12, Misra et al. disclose execution of an application (i.e. resource) on the shareable device. Misra et al. do not expressly disclose terminating the execution of the application on the shareable device by revoking the sharable license. Lopatic discloses terminating the execution of the application on the shareable device by revoking the sharable license (see paragraph [0032] – Lopatic teaches continuing an execution of the individual download copy if a permission to run is obtained and aborting the execution otherwise and claim 6 –the license has an expiration date that indicates a date on which the software license will expire) modify the method disclose by Misra et al. to include the step of terminating the execution of the second application on the shareable device after failing to receive a response verifying current execution of the first application on the master device. One of ordinary skill in

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the art would have been motivated to do this because it protects the rights of the software supplier and control the transfer of licenses (see paragraphs [0017] & [0018] of Lopatic).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. as applied to claim 8 above, and further in view of US Publication No. 2004/0039916 to Aldis et al.

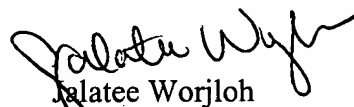
Misra et al. disclose shareable device and master device (see claim 8 above). Misra et al. do not expressly disclose receiving an option to upgrade the shareable device to operate as a second master device. Aldis et al. disclose receiving an option to upgrade the shareable device to operate as a second master device (see paragraph [0147] - Aldis et al. system allows client's to update their licenses for server-type products; since, this option is available can is suggested that a option to upgrade may be received). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Misra et al. reference to include the step of receiving an option to upgrade the shareable device to operate as a second master device. One of ordinary skill in the art would have been motivated to do this because it provides more flexibility to the clients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jalate Worjloh
Patent Examiner
Art Unit 3621

June 6, 2006